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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,439	05/04/2001	Hiroyoshi Tsuchiya	205822US0CONT	8695
22850	7590	11/10/2003	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			GUARRIELLO, JOHN J	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,439

Applicant(s)

TSUCHIYA ET AL.

Examiner

John J. Guarriello

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 32-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

15. The Examiner acknowledges the response, amendment of 8/23/2003, and the Restriction requirement affirmation with traverse to Group I, claims 1-23, 32-51. Claims 24-31 are withdrawn as to the non-elected invention, Group II. Rejoinder will be considered when the appropriate conditions of M.P.E.P. section 821.04 are satisfied. Since no arguments of traverse are noted, the Restriction is made final for reasons of record.

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied

by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

18. Claims 17, 18, 48, and 51 are objected to because of the following informalities: in claims 17 and 18 it is not clear if this is a stated ratio; in claims 48 and 51 it is not clear what the correct units are, since this appears to be a typographical error, "g/m.sup2". Appropriate correction is required.

Specification

19. The amendment filed 8/23/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the deletion of "but may not be necessarily" and the addition of "and are", regarding the orthogonality, page 30, line 14 is new matter. The Declaration by Itoh is insufficient to provide support. This amendment to the instant specification is contrary to the original disclosure regarding orthogonality.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1-23, 32, 34-51 are rejected under 35 U.S.C. 102(b) as anticipated by over Masaki et al. 5, 821, 179.

Masaki describes an absorbent sheet for use in sanitary napkins, disposable diapers, kitchen paper towel, and other similar articles, (column 1, lines 6-11), which corresponds to the claimed water absorptive composite comprising a fibrous substrate with water absorbing polymer particles with average particle diameter of 1.0 to 1000 microns, (column 12, lines 52-60), which encompasses the average particle diameter of the claimed invention. Masaki describes the amount of the polymer particles is at least 50% by weight or 70% by weight or more, (column 12, lines 1-5), which encompasses the claimed invention. Masaki describes the polymer particles in an amount of 5-300 g/square meter of the substrate, which encompasses the instant claims, (column 12, lines 40-42). Masaki describes the fibers for the substrate can be hydrophilic and can be natural or synthetic which encompass the claimed invention, (column 7, lines 64-

67; column 8, lines 1-15). Masaki describes the agglomerate of polymer particles, (column 12, lines 6-11). Masaki describes various shapes the agglomerate can have, (column 12, lines 55-58). Masaki describes the absorbent sheet can be nonwoven cloth, (column 35, lines 1-4). Masaki describes fluff pulp, (column 34, lines 59-64). Since the claimed components, chemistry and structure, are encompassed by Masaki, the remaining properties, claims 13-18, would be inherent. It is the Examiner's position that Masaki describes the essential limitations of the claimed invention. Claims lack novelty. In the alternative, it would have been obvious to one of ordinary skill to form agglomerates with the appropriate diameter since Masaki describes the average particle diameter and the other properties would be inherent since the basic structure and chemistry are describes by Makaki.

Applicant's arguments regarding the particle diameter were considered but are not persuasive the Sugyo declaration is not commensurate in scope with the claims. The declaration implies that

the process of making the absorbent article is critical, but the claims are directed to the article not the process of making.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masaki et al. 5,821,179 in view of Tsuchiya et al. 5,962,068.

Masaki as above in paragraph # 22 but differs since it is silent about the steps in the product by process claim.

Tsuchiya describes various conditions, steps so that the degree of polymerization when droplets reach the substrate, (column 7, lines 63-67). Tsuchiya describes some aspect of agglomerate even though difficult that can be accomplished, (column 1, lines 47-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use steps of Tsuchiya for

agglomerate production in the absorbent article production of Masaki motivated with the expectation that the absorbent article would still improve absorption of liquids even though somewhat difficult.

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J.

Guarriello whose telephone number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.




John J. Guarriello:gj

Patent Examiner

October 29, 2003

November 3, 2003



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700